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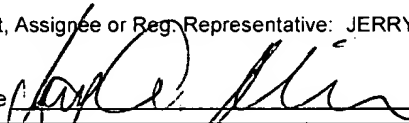
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s) : Hughes et al.  
Filed : 04/17/2001  
Serial No. : 09/836,631  
Confirmation No. : 7211  
Group Art Unit : 3621  
Examiner : Bashore, Alain L.  
Docket Number : 50P4092  
Title : Interface For Presenting Downloadable Digital Data Content Format Options

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

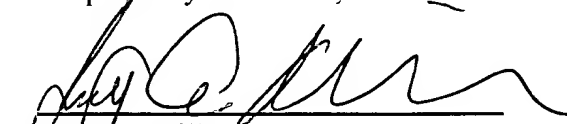
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Respectfully submitted,

  
Jerry A. Miller  
Registration No. 30,779  
Dated: 11/27/06

Please Send Correspondence to:  
Miller Patent Services  
2500 Dockery Lane  
Raleigh, NC 27606  
Phone: (919) 816-9981  
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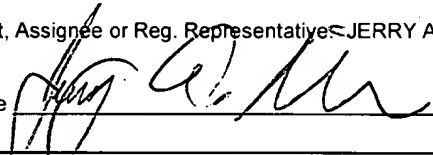
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In Re Patent Application of:

Inventor(s) : David A. Hughes, et al.  
Filed : April 17, 2001  
Application No. : 09/836,631  
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Examiner : Sherr, Cristina O.  
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Format Options

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Applicant, Assignee or Reg. Representative: JERRY A. MILLER Reg. No. 30,779	
Signature 	Date <u>11/27/06</u>

**AMENDED APPEAL BRIEF**

This amended appeal brief is submitted in **triplicate** and in response to the Office Action dated June 29, 2006 and the notice of Nov. 16, 2006. This brief replaces the originally filed brief in this appeal. Reconsideration and allowance of all claims at issue are respectfully requested.

The fee for this brief has been previously paid. The Director is authorized to deduct any underpayment or credit any overpayment to deposit account number 501257.

### **REAL PARTY IN INTEREST**

The real parties in interest in this appeal are the assignees of this application - Sony Corporation and Sony Music Entertainment Inc.

### **RELATED APPEALS AND INTERFERENCES**

None known to the undersigned.

### **STATUS OF CLAIMS**

Claims 1-29 are pending in this application and currently stand rejected in a sixth non-final Office Action. Claims 1-29 are presently rejected based upon 35 U.S.C.103(a) as being unpatentable over Appellants' alleged admitted prior art ("AAPA") and U.S. Pat. No. 6,460,076 ("Srinivasan") in view of U.S. Pat. No. 5,629,980 ("Stefik").

### **STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION**

No amendments have been filed subsequent to final rejection. The present claims are not under final rejection, however, in view of this being the sixth rejection received by Appellants, appeal is appropriate at this time since the claims are at least twice rejected.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

The following summary is supplied in compliance with the requirements of the appeal rules. The undersigned wishes to note that this summary is provided merely as an aid to the Board in rapidly understanding the invention and the issues relating to this appeal and do not supersede what the claims actually state (69 Fed. Reg. 155 (Aug., 2004)). As such, this summary should not be construed to limit the invention in any way. The figure and element numbers provided in this summary are illustrative and not necessarily the exclusive reading of the claim language.

The following summaries have been expanded to include summaries of each claim in response to the notice of Nov. 16, 2006. The summaries are arranged by claim group as indicated below:

### Claim Group 1

Claim 1 is representative of Claim Group 1 below. In accordance with certain embodiments consistent with the present invention as characterized for example in claim 1, a method of facilitating a transaction for downloadable digital data over an electronic network involves (see paragraph [0005] generally):

maintaining a presence (Figs. 1, 3 and 5, element 30) to which a consumer (Figs. 1 and 5, element 20) connects on the electronic network (Fig. 1, element 10);

transmitting a page (Fig. 6A, paragraph [0018]) from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data;

receiving a command (Fig. 7, element 304, paragraph [0037]) from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data; and

transmitting format options (element 46 of Fig. 4, Fig. 8C-8F generally, paragraphs [0058]-[0065]) from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of (i) types of software on which the downloadable digital data is to be executable (218 of Fig. 8c, 28B of Fig. 2); (ii) types of portable devices on which the downloadable digital data is to be stored (28c of Fig. 2, 220 of Fig. 8c); (iii) types of compression formats in which the downloadable digital data is to be configured (218 of Fig. 8c, paragraph [0060]); (iv) types of CODECs through which the downloadable digital data is to be processed (218 of Fig. 8c, 28B of Fig. 2); and (v) types of digital rights management to which the downloadable digital data is to be subjected (218 of Fig. 8c, 28A of Fig. 2).

Regarding claims 7, 17 and 24 the downloadable digital data includes at least one of audio data, video data, and text data (paragraph [0020]).

Regarding claims 8, 18 and 25 each type of software (218 of Fig. 8c, 28B of Fig. 2), each type of compression format (218 of Fig. 8c, paragraph [0060]), each type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and each type of portable device (28c of Fig. 2, 220 of Fig. 8c) is displayed on the page and selectable by way of activation by the consumer is further supported at paragraph [0030] and [0062].

Regarding claim 9, receiving the consumer's selection of at least one of the type of software (218 of Fig. 8c, 28B of Fig. 2), the type of compression format (218 of Fig. 8c, paragraph [0060]), the type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the type of portable device (28c of Fig. 2, 220 of Fig. 8c), over the electronic network at the presence is further supported at [0058]-[0065], Figs. 1 and 5 generally, and Figs. 8C-8E and original claim 9.

Regarding claims 10 and 11 transmitting and storing the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software (218 of Fig. 8c, 28B of Fig. 2), the selected type of compression format (218 of Fig. 8c, paragraph [0060]), the selected type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the selected type of portable device (28c of Fig. 2, 220 of Fig. 8c) is supported generally at [0064]-[0071].

Regarding claim 13, 20 and 27 the portable devices (28c of Fig. 2, 220 of Fig. 8c) on which the downloadable digital data stores data in a manner that is compliant with secure digital music initiative (SDMI) specifications is supported at [0059].

Regarding claim 14, 21 and 28 the electronic network comprises the Internet and comprises a web site thereon is supported at paragraph [0017] and Figs. 1 and 5 generally.

Regarding claim 15, a system for facilitating a transaction for downloadable digital data over an electronic network (Figs. 1 and 5 generally), comprising: means for maintaining a presence (30 of Figs. 1, 3 and 5 generally) operating under the software (described generally throughout the specification) to which a consumer connects on the electronic network (10 of Figs. 1 and 5); means for transmitting a page from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data (30 of Figs. 1, 3 and 5; and 302 of Fig. 7); means for receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data (30 of Figs. 1, 3 and 5; and 304 of Fig. 7; and means for transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of (i) types of software on which the downloadable digital data is to be executable (218 of Fig. 8c, 28B of Fig.

2); (ii) types of portable devices on which the downloadable digital data is to be stored (28c of Fig. 2, 220 of Fig. 8c); (iii) types of compression formats (218 of Fig. 8c, paragraph [0060]) in which the downloadable digital data is to be configured; (iv) types of CODECs through which the downloadable digital data is to be processed (218 of Fig. 8c, 28B of Fig. 2); and (v) types of digital rights management to which the downloadable digital data is to be subjected (218 of Fig. 8c, 28A of Fig. 2, 40 of Fig. 1 and 4 and Fig. 8C-8E, paragraphs [0006], [0058] and [0065]) . .

Regarding claim 19, means (48 of Fig. 4) for transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software (40 of Figs. 1, 4 and 5 and Fig. 4, 218 of Fig. 8c, 28B of Fig. 2), the selected type of compression format (218 of Fig. 8c, paragraph [0060]), the selected type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the selected type of portable device are supported at Fig. 8F-8G, paragraph [0068], 28c of Fig. 2, and 220 of Fig. 8c. See also [0058]-[0071] generally and Fig. 8c-8d.

Regarding claim 22, the electronic storage medium is supported throughout the specification and in particular at paragraph [0074]. The instructions themselves are described in the method claim 1 and is supported as noted above.

Regarding claim 26, the means for transmitting (40 of Figs. 1, 4 and 5) the downloadable digital data to the consumer over the electronic network (10 of Fig. 1) in a format consistent with at least one of the selected type of software (218 of Fig. 8c, 28B of Fig. 2), the selected type of compression format (218 of Fig. 8c, paragraph [0060]), the selected type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the selected type of portable device is supported at 48 of Fig. 4, paragraph [0031], 28c of Fig. 2 and 220 of Fig. 8c. See also generally [0058]-[0071] and Fig. 8c-8d.

## Claim Group 2

Claim 2 is representative of Claim Group 2 below. Each claim in this group (2, 16 and 23 are substantially identical in the additional claim features added in dependent form to their respective parents). In this embodiment (46 of Fig. 4, Fig. 8C-8F, paragraphs 6, 64-65), at least one of (i) a given type of software (218 of Fig. 8c, 28B of Fig. 2) is compatible with respective

subsets of at least one of the types of compression formats (218 of Fig. 8c, paragraph [0060]), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c); (ii) a given type of compression format (218 of Fig. 8c, paragraph [0060]) is compatible with respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c); (iii) a given type of digital rights management (218 of Fig. 8c, 28A of Fig. 2) is compatible with respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c); and (iv) a given type of portable device is compatible with respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2).

### Claim Group 3

Claims 3-6 make up Claim Group 3 below. In the embodiment of claim 3, the consumer is permitted to make selections from among only the compatible respective subsets of at least one of the types of compression formats (218 of Fig. 8c, paragraph [0060]), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c), when the given type of software (218 of Fig. 8c, 28B of Fig. 2) is selected by the consumer (46 of Fig. 4, paragraphs [0061]-[0066]).

In the embodiment of claim 4, the consumer is permitted to make selections from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c), when the given type of compression format (218 of Fig. 8c, paragraph [0060]) is selected by the consumer (46 of Fig. 4, paragraphs [0061]-[0066]).

In the embodiment of claim 5, the consumer is permitted to make selections from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c,

28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of portable devices (28c of Fig. 2, 220 of Fig. 8c), when the given type of digital rights management (218 of Fig. 8c, 28A of Fig. 2) is selected by the consumer (46 of Fig. 4, paragraphs [0061]-[0066]).

In the embodiment of claim 6, the consumer is permitted to make selections from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), when the given type of portable device (28c of Fig. 2, 220 of Fig. 8c) is selected by the consumer (46 of Fig. 4, paragraphs [0061]-[0066]).

#### Claim Group 4

Claim 12 is representative of Claim Group 4 below. In this embodiment (46 of Fig. 4, paragraph 71) selections are stored and the selections of a stored type of software (218 of Fig. 8c, 28B of Fig. 2), type of compression format (218 of Fig. 8c, paragraph [0060]), type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and type of portable device (28c of Fig. 2, 220 of Fig. 8c) as default format options and transmitting the default format options (paragraph [0071]) from the presence to the consumer over the electronic network via the page in response to another command from the consumer over the electronic network indicating that the consumer is engaging in another transaction for downloadable digital data.

#### Claim Group 5

Claim 29 is representative of Claim Group 5 below. This embodiment incorporates each elements described in each of the above descriptions and therefore need not be further described in detail. However, in view of the Notice of Nov. 16, 2006, claim 29 is summarized as follows:

A method of facilitating a transaction for downloadable digital data over an electronic network, the method comprising:

maintaining a presence (Figs. 1, 3 and 5, element 30) to which a consumer (Figs. 1 and 5, element 20) connects on the electronic network (Fig. 1, element 10), wherein the presence is



operative to receive a consumer connection, and wherein the electronic network comprises the Internet (element 10 of Figs. 1 and 5) and the presence comprises a web site on the Internet (paragraph [0018]);

transmitting a page (Fig. 6A, paragraph [0018]) from the presence (30) over the electronic network (10) to the consumer, wherein the page includes information concerning the downloadable digital data, and wherein the downloadable digital data includes at least one of audio data, video data, and text data (paragraph [0020]);

receiving a command (Fig. 7, element 304, paragraph [0037]) from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data;

transmitting format options from the presence over the electronic network via the page to the consumer, wherein the format options are selectable by the consumer and include at least one of (i) types of software on which the downloadable digital data is to be executable (218 of Fig. 8c, 28B of Fig. 2); (ii) types of portable devices (28c if Fig. 2, 220 of Fig. 8c) on which the downloadable digital data is to be stored; (iii) types of compression formats in which the downloadable digital data is to be configured (218 of Fig. 8c, paragraph [0060]); (iv) types of CODECs through which the downloadable digital data is to be processed (218 of Fig. 8c, 28B of Fig. 2); and (v) types of digital rights management to which the downloadable digital data is to be subjected (218 of Fig. 8c, 28A of Fig. 2);

wherein at least one of (i) a given type of software (218 of Fig. 8c, 28B of Fig. 2) is compatible with respective subsets of at least one of the types of compression formats (218 of Fig. 8c, paragraph [0060]), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c); (ii) a given type of compression format (218 of Fig. 8c, paragraph [0060]) is compatible with respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c); (iii) a given type of digital rights management (218 of Fig. 8c, 28A of Fig. 2) is compatible with respective subsets of at least one of

the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c); and (iv) a given type of portable device (28c if Fig. 2, 220 of Fig. 8c) is compatible with respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2);

wherein when a type of software (218 of Fig. 8c, 28B of Fig. 2) is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of compression formats (218 of Fig. 8c, paragraph [0060]), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c);

wherein when a type of compression format (218 of Fig. 8c, paragraph [0060]) is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c);

wherein when a type of digital rights management (218 of Fig. 8c, 28A of Fig. 2) is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of Fig. 8c, paragraph [0060]), and the types of portable devices (28c if Fig. 2, 220 of Fig. 8c);

wherein when a type of portable device (28c if Fig. 2, 220 of Fig. 8c) is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software (218 of Fig. 8c, 28B of Fig. 2), the types of compression formats (218 of

Fig. 8c, paragraph [0060]), and the types of digital rights management (218 of Fig. 8c, 28A of Fig. 2);

wherein each type of software (218 of Fig. 8c, 28B of Fig. 2), each type of compression format (218 of Fig. 8c, paragraph [0060]), each type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and each type of portable device (28c if Fig. 2, 220 of Fig. 8c) is displayed on the page and selectable by way of activation by the consumer;

receiving the consumer's selection of at least one of the type of software (218 of Fig. 8c, 28B of Fig. 2), the type of compression format (218 of Fig. 8c, paragraph [0060]), the type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the type of portable device (28c if Fig. 2, 220 of Fig. 8c), over the electronic network at the presence;

transmitting the downloadable digital data over the electronic network to the consumer in a format consistent with at least one of the selected type of software (218 of Fig. 8c, 28B of Fig. 2), the selected type of compression format (218 of Fig. 8c, paragraph [0060]), the selected type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the selected type of portable device (28c if Fig. 2, 220 of Fig. 8c);

storing an indication of at least one of the selected type of software (218 of Fig. 8c, 28B of Fig. 2), the selected type of compression format (218 of Fig. 8c, paragraph [0060]), the selected type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and the selected type of portable device (28c if Fig. 2, 220 of Fig. 8c);

designating the indication of the stored type of software (218 of Fig. 8c, 28B of Fig. 2), type of compression format (218 of Fig. 8c, paragraph [0060]), type of digital rights management (218 of Fig. 8c, 28A of Fig. 2), and type of portable device (28c if Fig. 2, 220 of Fig. 8c) as default format options (paragraph [0071]); and

transmitting the default format options from the presence over the electronic network via a second page to the consumer in response to another command from the consumer over the electronic network, wherein the another command indicates that the consumer is engaging in another transaction for downloadable digital data.

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 1-29 are obvious in view of the cited art as broken down in the claim groupings below.

## **GROUPING OF CLAIMS**

Appellants currently group the claims for consideration in this appeal as follows:

Group 1 – Claims 1, 7-11, 13-15, 17-22, 24-28;

Group 2 – Claims 2, 16, 23;

Group 3 – Claims 3, 4, 5, 6;

Group 4 – Claim 12; and

Group 5 – Claim 29.

Appellants note that the extraordinary brevity of the present Office Action makes it impossible to fully consider the appropriateness of this grouping and reserves the right to change this grouping if the Examiner's Answer provides better understanding of the current rejections.

## **ARGUMENTS**

This argument section is divided in two parts. In the first part, Appellants present three main arguments relevant to the rejections in general and discuss the four points upon which the Examiner appears to base the rejections. In the second part, Appellants present arguments relevant to specific claims.

### **Regarding the rejections in general:**

A- The Office Action is Deficient at least under MPEP 707, 707.07(d) and (i), and under 37 C.F.R. 1.104 (c)(2).

37 C.F.R. 1.104 (c)(2) states:

“(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the Appellant, *the particular part relied on must be designated as nearly as practicable. The*

***pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.***” (emphasis added)

The present rejection is a sixth rejection of the claims citing entirely new art and borders on an “omnibus” rejection as outlined and prohibited in MPEP 707.07(d). The present rejection is nearly devoid of explanation as to the nature of the rejection and how the cited art is being applied to the claims. As such, Appellants respectfully believe the rejections are improper.

It is unclear to the undersigned if, in general, this deficiency in examination is an appealable or petitionable matter, but since the extreme brevity of the Office Action has bearing on its failure to establish a case of *prima facie* obviousness, these matters are believed appropriate for consideration during appeal and are raised herein.

In view of the brevity of the present rejection, Appellants reserve the right to amend this Appeal to modify the grouping of the claims and arguments presented herein if the Examiner provides additional insight into the rejection in her Answer.

B- *Prima Facie* Obviousness Has Not Been Established Because The Examiner Has Failed To Consider Each And Every Claim Feature.

For a *Prima Facie* showing of obviousness, MPEP 2143.03 requires that all claim limitations must be taught or suggested. To summarize the claim rejections, the most recent Office Action asserts the following (and only the following) four items as the bases for all rejections:

- 1- AAPA and Srinivasan “show all the limitations of the claims except for [the] types of digital data management to which the digital data is to be subjected. For example Samgoody.com offers the purchase of CD’s, tapes, DVD’s, etc., containing music and/or video via the Internet, and allowing the buyer to choose the format of the music or video at the time of purchase. It is also well known to download digital data over the Internet.”
- 2- “Srinivasan shows a system and method for selling downloadable products over the Internet.”
- 3- “Stefik et al for controlling the distribution and use of digital works.” [sic]
- 4- A conclusion that it would be obvious to combine these teachings.

The quotation of rejection basis 1 apparently relates to the disclosure of paragraph 3 of Appellants' application, which states:

"It is known to browse for, and purchase, goods over the Internet. For example, SamGoody.com offers the purchase of CDs, tapes, DVDs, etc. containing music and/or video via the Internet. It is also known to download digital data over the Internet."

Appellants make no admission beyond the literal words of this statement and specifically have not admitted that a buyer is allowed to choose a format of the music or video at the time of purchase. However, it is noted that the claims require more than simply selection of a format.

Regarding rejection basis 2 above, Appellants are unable to find a disclosure in Srinivasan of selection of formats as asserted in rejection basis 1 above.

Regarding rejection basis 3 above, Appellants presume that this is intended to mean that the features relating to digital rights management (DRM) are shown in Stefik. Stefik contains 58 columns of text and 19 figures of drawing. The latest Office Action fails to provide any guidance as to how Stefik's alleged teachings are being applied to the current claims, and Appellants have been unable to identify teachings adequate to meet the claim features.

By way of example, and not by way of grouping of claims for separate consideration in this appeal, consider claim 1, which requires,

"... transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of

- (i) types of software on which the downloadable digital data is to be executable;
- (ii) types of portable devices on which the downloadable digital data is to be stored;
- (iii) types of compression formats in which the downloadable digital data is to be configured;
- (iv) types of CODECs through which the downloadable digital data is to be processed; and
- (v) types of digital rights management to which the downloadable digital data is to be subjected."

Similar requirements are present in each claim on appeal.

None of the cited references are believed to fairly teach or suggest transmitting format options from the presence to the consumer on the page for selection by the consumer, as called out in this illustrative claim. Hence, all claim limitations have not been fully and properly considered.

Presumably, in view of the Examiner's remarks about the AAPA's and Srinivason's failure to teach DRM, the Examiner appears to rely upon Stefik to teach the claim element related to "(v) types of digital rights management to which the downloadable digital data is to be subjected". However, Appellants can find no teaching or suggestion in the cited art for providing choices of types of DRM that are presented in a page from a presence to a customer as a format option for selection as part of the download process, as called for by the remainder of the claim. Without further guidance, Appellants have no idea how the Examiner is applying the art and find no such teaching or suggestion in the combination proposed.

In view of the above deficiencies, it is clear that all claim limitations have not been fully and properly considered, since doing so would require consideration of each and every word of the claim. One could reasonably expect to have an explanation of where all claim limitations could be found in the references. The most recent Office Action provides no such guidance. The Examiner has failed to establish a *prima facie* showing of obviousness.

Rejection basis number 4 is discussed next.

C- Prima Facie Obviousness Has Not Been Established Because The Examiner Has Failed To Provide Adequate Motivation In The Art To Make The Proposed Combination.

MPEP 2143.01 requires that there be a suggestion or motivation to modify or combine the references in order to establish *prima facie* obviousness. The latest Office Action presents the following as motivation, from paragraph 8:

"Based upon the teaching of Stefik et al, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the two methods of selling and distributing works over a network in order to increase both flexibility and security". (emphasis added)

It is respectfully submitted to the Board that more is required than a statement that the combination would "increase flexibility and security". The Examiner has not provided the

necessary evidence to show that it would have been obvious to one of ordinary skill in the art to modify the primary references to bring about the claimed functions. In the absence of such evidence, the motivation provided in the most recent Office Action is merely a broad conclusory statement. The CAFC has often repeated that “the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3D 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (“the range of sources available does not diminish the requirement for **actual evidence**”, and “broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence”) (emphasis added).

Appellants respectfully submit for the Board’s consideration that “increasing flexibility and security” is an overbroad assertion of a motivation to combine references. If such reasoning were viable, then one might as well say that “to make it better” is a viable motivation. But the CAFC does not allow such broad reasoning. In view of the clear lack of evidence for making the proposed combination, there is clearly no *prima facie* obviousness.

#### **Regarding the rejections of particular claims:**

##### **Claim Group 1**

General arguments A, B, and C above are applicable. None of the cited art is believed to teach or suggest the claims taken as a whole, including full consideration of each word of the claims. Reconsideration and allowance of these claims is respectfully requested.

##### **Claim Group 2**

General arguments A, B, and C above are applicable. None of the cited art is believed to teach or suggest the claims taken as a whole, including full consideration of each word of the claims.

Claims 2, 16, and 23 further call for details of the compatibility of software, compression format, DRM, and a portable device. Appellants find no teaching or suggestion for these claim requirements in the proposed combination of the cited references. Moreover, the Office Action fails to identify any location where such teachings or suggestions can be found.



Reconsideration and allowance of these claims is respectfully requested.

#### Claim Group 3

General arguments A, B, and C above are applicable. None of the cited art is believed to teach or suggest the claims taken as a whole, including full consideration of each word of the claims.

Each of these claims further requires that the consumer is permitted selection from among only the compatible subsets of selections. As an illustrative example, but not by way of further limitation, when a compression format is selected, the consumer's further selections are restricted to those devices and software products that are compatible with the compression format. Appellants are unable to find any teaching or suggestion of these features in the cited art.

Reconsideration and allowance of these claims is respectfully requested.

#### Claim Group 4

General arguments A, B, and C above are applicable. None of the cited art is believed to teach or suggest the claim taken as a whole, including full consideration of each word of the claim.

This claim further requires summarizing without intent of imposing limitations, storing at least one of the consumer's selections, and designating the stored selections as a default. Appellants are unable to find any teaching or suggestion of these features in the cited art.

Reconsideration and allowance of this claim is respectfully requested.


#### Regarding Group 5

General arguments A, B, and C, as well as the remarks about Claim Groups 1-4 are all applicable to the rejection of claim 29. None of the cited art is believed to teach or suggest the claim taken as a whole, including full consideration of each word of the claim. This claim comprehensively incorporates virtually all features claimed in virtually all of claims 1-21.

Clearly, none of the cited art teaches or suggests all features of this claim for the reasons stated above and others.

Reconsideration and allowance of this claim is respectfully requested.

Respectfully submitted,

  
Jerry A. Miller  
Registration No. 30,779

Dated: 11/27/66

Please Send Correspondence to:  
Miller Patent Services  
2500 Dockery Lane  
Raleigh, NC 27606  
Phone: (919) 816-9981  
Fax: (919) 816-9982  
**Customer Number 24337**

## **CLAIMS APPENDIX**

1. (Previously Presented) A method of facilitating a transaction for downloadable digital data over an electronic network, the method comprising:

maintaining a presence to which a consumer connects on the electronic network;

transmitting a page from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data;

receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data; and

transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of (i) types of software on which the downloadable digital data is to be executable; (ii) types of portable devices on which the downloadable digital data is to be stored; (iii) types of compression formats in which the downloadable digital data is to be configured; (iv) types of CODECs through which the downloadable digital data is to be processed; and (v) types of digital rights management to which the downloadable digital data is to be subjected.

2. (Previously Presented) The method of claim 1, wherein at least one of (i) a given type of software is compatible with respective subsets of at least one of the types of compression formats, the types of digital rights management, and the types of portable devices; (ii) a given type of compression format is compatible with respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices; (iii) a given type of digital rights management is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices; and (iv) a given type of portable device is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management.

3. (Previously Presented) The method of claim 2, further comprising permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of

compression formats, the types of digital rights management, and the types of portable devices, when the given type of software is selected by the consumer.

4. (Previously Presented) The method of claim 2, further comprising permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices, when the given type of compression format is selected by the consumer.

5. (Previously Presented) The method of claim 2, further comprising permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices, when the given type of digital rights management is selected by the consumer.

6. (Previously Presented) The method of claim 2, further comprising permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management, when the given type of portable device is selected by the consumer.

7. (Original) The method of claim 1, wherein the downloadable digital data includes at least one of audio data, video data, and text data.

8. (Previously Presented) The method of claim 1, wherein each type of software, each type of compression format, each type of digital rights management, and each type of portable device is displayed on the page and selectable by way of activation by the consumer.

9. (Previously Presented) The method of claim 1, further comprising receiving the consumer's selection of at least one of the type of software, the type of compression format, the type of digital rights management, and the type of portable device, over the electronic network at the presence.

10. (Previously Presented) The method of claim 9, further comprising transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device.

11. (Previously Presented) The method of claim 10, further comprising storing at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device.

12. (Previously Presented) The method of claim 11, further comprising designating the stored type of software, type of compression format, type of digital rights management, and type of portable device as default format options and transmitting the default format options from the presence to the consumer over the electronic network via the page in response to another command from the consumer over the electronic network indicating that the consumer is engaging in another transaction for downloadable digital data.

13. (Previously Presented) The method of claim 1, wherein the portable devices on which the downloadable digital data stores data in a manner that is compliant with secure digital music initiative (SDMI) specifications.

14. (Previously Presented) The method of claim 1, wherein the electronic network comprises the Internet and comprises a web site thereon.

15. (Previously Presented) A system for facilitating a transaction for downloadable digital data over an electronic network, comprising:

means for maintaining a presence to which a consumer connects on the electronic network;

means for transmitting a page from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data;

means for receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data; and

means for transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of (i) types of software on which the downloadable digital data is to be executable; (ii) types of portable devices on which the downloadable digital data is to be stored; (iii) types of compression formats in which the downloadable digital data is to be configured; (iv) types of CODECs through which the downloadable digital data is to be processed; and (v) types of digital rights management to which the downloadable digital data is to be subjected.

16. (Previously Presented) The system of claim 15, wherein at least one of (i) a given type of software is compatible with respective subsets of at least one of the types of compression formats, the types of digital rights management, and the types of portable devices; (ii) a given type of compression format is compatible with respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices; (iii) a given type of digital rights management is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices; and (iv) a given type of portable device is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management.

17. (Original) The system of claim 15, wherein the downloadable digital data includes at least one of audio data, video data, and text data.

18. (Previously Presented) The system of claim 15, wherein each type of software, each type of compression format, each type of digital rights management, and each type of portable device is displayed on the page and selectable by way of activation by the consumer.

19. (Previously Presented) The system of claim 15, further comprising means for transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device.

20. (Previously Presented) The system of claim 15, wherein the portable devices on which the downloadable digital data stores data in a manner that is compliant with secure digital music initiative (SDMI) specifications.

21. (Previously Presented) The system of claim 15, wherein the electronic network comprises Internet and the presence comprises a web site thereon.

22. (Previously Presented) An electronic storage medium for storing instructions which, when executed by a programmable controller, carry out a method for facilitating a transaction for downloadable digital data over an electronic network, comprising:

maintaining a presence to which a consumer connects on the electronic network;

transmitting a page from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data;

receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data; and

transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of (i) types of software on which the downloadable digital data is to be executable; (ii) types of portable devices on which the downloadable digital data is to be stored; (iii) types of compression formats in which the downloadable digital data is to be configured; (iv) types of CODECs through which the downloadable digital data is to be processed; and (v) types of digital rights management to which the downloadable digital data is to be subjected.

23. (Previously Presented) The electronic storage medium of claim 22, wherein at least one of (i) a given type of software is compatible with respective subsets of at least one of the types of compression formats, the types of digital rights management, and the types of portable devices; (ii) a given type of compression format is compatible with respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices; (iii) a given type of digital rights management is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices; and (iv) a given type of portable device is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management.

24. (Original) The electronic storage medium of claim 22, wherein the downloadable digital data includes at least one of audio data, video data, and text data.

25. (Previously Presented) The electronic storage medium of claim 22, wherein each type of software, each type of compression format, each type of digital rights management, and each type of portable device is displayed on the page and selectable by way of activation by the consumer.

26. (Previously Presented) The electronic storage medium of claim 22, further comprising means for transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device.

27. (Previously Presented) The electronic storage medium of claim 22, wherein the portable devices on which the downloadable digital data stores data in a manner that is compliant with secure digital music initiative (SDMI) specifications.



28. (Previously Presented) The electronic storage medium of claim 22, wherein the electronic network comprises the Internet and the presence comprises a web site thereon.

29. (Previously Presented) A method of facilitating a transaction for downloadable digital data over an electronic network, the method comprising:

maintaining a presence to which a consumer connects on the electronic network, wherein the presence is operative to receive a consumer connection, and wherein the electronic network comprises the Internet and the presence comprises a web site on the Internet;

transmitting a page from the presence over the electronic network to the consumer, wherein the page includes information concerning the downloadable digital data, and wherein the downloadable digital data includes at least one of audio data, video data, and text data;

receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data;

transmitting format options from the presence over the electronic network via the page to the consumer, wherein the format options are selectable by the consumer and include at least one of (i) types of software on which the downloadable digital data is to be executable; (ii) types of portable devices on which the downloadable digital data is to be stored; (iii) types of compression formats in which the downloadable digital data is to be configured; (iv) types of CODECs through which the downloadable digital data is to be processed; and (v) types of digital rights management to which the downloadable digital data is to be subjected;

wherein at least one of (i) a given type of software is compatible with respective subsets of at least one of the types of compression formats, the types of digital rights management, and the types of portable devices; (ii) a given type of compression format is compatible with respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices; (iii) a given type of digital rights management is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices; and (iv) a given type of

portable device is compatible with respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management;

wherein when a type of software is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of compression formats, the types of digital rights management, and the types of portable devices;

wherein when a type of compression format is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of digital rights management, and the types of portable devices;

wherein when a type of digital rights management is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of compression formats, and the types of portable devices;

wherein when a type of portable device is selected by the consumer, the method further comprises permitting selection by the consumer from among only the compatible respective subsets of at least one of the types of software, the types of compression formats, and the types of digital rights management;

wherein each type of software, each type of compression format, each type of digital rights management, and each type of portable device is displayed on the page and selectable by way of activation by the consumer;

receiving the consumer's selection of at least one of the type of software, the type of compression format, the type of digital rights management, and the type of portable device, over the electronic network at the presence;

transmitting the downloadable digital data over the electronic network to the consumer in a format consistent with at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device;

storing an indication of at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device;

designating the indication of the stored type of software, type of compression format, type of digital rights management, and type of portable device as default format options; and

transmitting the default format options from the presence over the electronic network via a second page to the consumer in response to another command from the consumer over the electronic network, wherein the another command indicates that the consumer is engaging in another transaction for downloadable digital data.

## **EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.

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